

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAACKI HIROKI and AKIRA MASE

Appeal No. 1998-2865
Application 08/372,899

ORDER REMANDING TO EXAMINER

An examination of the file reveals that an Information Disclosure Statement (IDS) was filed March 19, 1993 (Paper No. 3). It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

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Section 609 IIIC(2) of the Manual of Patent Examining Procedure (MPEP) (8th Edition, August 2001) which deals with Information Disclosure Statements states:

Examiners must consider all citations submitted in conformance with the rules of this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 or PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office. The examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form. (Emphasis added.)

The IDSs filed on January 16, 2001 (Paper No. 44), October 5, 2001 (Paper No. 45) and April 30, 2002 (Paper No. 46) are deficient because they do not contain the examiner's name and date of consideration at the bottom of PTO-1449s. Correction is required.

In addition, the Contents page of the application file notes that a miscellaneous letter was mailed May 21, 2003 (Paper No. 49. However, this paper appears to be missing from the file.

Finally, on September 14, 1998, a "REQUEST FOR AMENDMENT OF INVENTORSHIP IN ACCORDANCE WITH 37 C.F.R. 1.48(a)" was filed (Paper No. 34) which requested that Shunpei Yamazaki be

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added as an inventor. The Office communication from the examiner mailed October 27, 1998 (Paper No. 34 [sic, 35] stated:

[T]his application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding an inventor's name of Shunpei Yamazaki.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

It should be noted that the file jacket and the PTO PALM data still reflect that there are only two inventors (HIROKI and MASE). Correction to the file jacket and PALM database is requested.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for consideration of the IDS filed March 19, 1993 (Paper No. 3) and appropriate written notification to appellants regarding the Examiner's decision;

2. for correction to the IDSs filed on January 16, 2001, October 5, 2001 and April 30, 2002 (Paper Nos. 44, 45

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and 46) by providing the examiner's signature and date of consideration at the bottom of PTO-1449s;

3. for placing a copy of the miscellaneous letter mailed May 21, 2003 (Paper No. 49) in the application file;

4. for correction to the file jacket and PALM database by adding Shunpei Yamazaki as an inventor, and for issuance of a corrected filing receipt (if necessary); and

5. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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